

Application No. 09/738,992

of Simonoff, U.S. Patent No. 6,351,777 (hereinafter referred to as "Simonoff"), further in view of Cass, U.S. Patent No. 5,692,073 (hereinafter referred to as "Cass"). In addition similar to the Office Action of April 20, 2005, the Office Action of October 6, 2005, on pages 13-14, rejects claims 7 and 18, under 35 USC 103(a) as being unpatentable over Carleton in view of Tran and Simonoff and further in view of Levine et al., U.S. Patent No. 5,680,636 (hereinafter referred to as "Levine"), further in view of Cass. In response thereto, Applicant incorporates herein by reference remarks on pages 7-11 set forth in an Amendment filed July 21, 2005.

## 2. Response to Comments Regarding Applicant's Remarks

On pages 14-15 of the Office Action of October 6, 2005, the Office Action sets forth responses to Applicant's arguments. Applicant respectfully request reconsideration of claims 1-22 for the following reasons:

(A) The Office Action on page 14, last paragraph, asserts that Tran "teaches the computer system with handwriting annotation". However, handwriting referred to in Tran concerns a handwriting recognizer of a pen-based computer, such as GRAFFITI (see Tran column 8, line 60 to column 9, line 67), unlike Applicant's claimed invention which recites in independent claims 1, 11, and 12, the identification of annotations in digital images of hardcopy documents and subsequent distribution to a plurality of workstations. That is, while Tran concerns an application for a pen-based computer, Applicant's claimed invention concerns an application for collaboratively working on a hardcopy document.

(B) Further, the Office Action on page 14, last paragraph, asserts that the cited references teach collaboration on paper documents as claimed by Applicant. Applicant respectfully disagrees and maintains that none of the cited sections of the references disclose or suggest, singly or in combination, sharing annotations on hardcopy documents as claimed by Applicant in independent claims 1, 11, and 12. See Applicant's remarks starting on page 9, last (partial) paragraph overlapping to page 10. In contrast, Cass concerns a method which involves identifying whether an active element on a hardcopy form has been marked, and performing an action associated with the marked active element (See Cass Abstract.).

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(C) Finally, the Office Action on page 15, first paragraph, asserts that those skilled in the art would have been motivated to combine the teachings of Carlton, Tran, Simonoff and Levine together to arrive at Applicant's claimed invention. In doing so, the Office Action cites Hanson et al., U.S. Patent 6,507,865 (hereinafter referred to as "Hanson"), and Kumar et al., U.S. Patent 6,342,906 (hereinafter referred to as "Kumar") in support thereof. Applicant respectfully requests that in a future correspondence, if Hanson and Kumar are to be relied on in rejecting Applicant's claimed invention, they be specifically cited so that Applicant may respond directly thereto. With specific reference to Hanson and Kumar, again similar to the cited references Carlton, Tran, Simonoff, and Levine (except for Cass), Hanson and Kumar do not concern the capture of digital images of hardcopy documents and subsequent identification of handwritten annotations therein, as claimed by Applicant. Instead, Hanson concerns the creation of an electronic form that may be used with the collaboration of electronically created content, while Kumar concerns collaborative computer sessions with two or more people sharing the same workspace (see Hanson and Kumar Abstracts).

Accordingly, Applicant respectfully submits for the reasons set forth above that independent claims 1, 11, and 12, are patentable in view of Carlton, Tran, Simonoff, Levine, Hanson, and Kumar as the cited sections in the references fail to disclose or suggest Applicant's claimed invention which recites: capturing a digital image of a hardcopy documents at a plurality of workstations; identifying handwritten annotations in the captured images; communicating data representing the handwritten annotations to the plurality of workstations; displaying the hardcopy document at the workstations while selectively displaying the annotations in accordance with the display criteria of each workstation. Insofar as claims 2-10 and 13-22 are concerned, these claims depend from presumably allowable independent claims 1 and 12 and are also therefore believed to be in condition for allowance.

### 3. Fee Authorization And Extension Of Time

No additional fee is believed to be required for this amendment or response, however, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No.

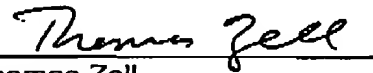
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24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

4. Conclusion

In view of the foregoing remarks, reconsideration of this application and allowance thereof are earnestly solicited. In the event the Examiner considers a personal contact advantageous to the disposition of this case, the Examiner is hereby requested to call Attorney for Applicant(s), Thomas Zell.

Respectfully submitted,



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Date: December 6, 2005